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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,526	12/08/2006	Richard Spitz	10191/4608	9368
26646 7590 08/26/2010 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
HSIEH, HSIN YI				
ART UNIT		PAPER NUMBER		
2811				
MAIL DATE		DELIVERY MODE		
08/26/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/575,526

**Applicant(s)**

SPITZ ET AL.

**Examiner**

Hsin-Yi (Steven) Hsieh

**Art Unit**

2811

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-24 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/05/2010 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings filed on 02/05/2010 is the original Figure 1 (7 pages of figures) filed on 4/10/2006 designated by a legend of "Prior Art", while it really should be the Figure 1 of the preliminary amendment (2 pages of figures) filed on 4/10/2006 designated by a legend of "Prior Art". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 18 recites the limitation "the bevels" in the first two lines of the claim. There is insufficient antecedent basis for this limitation in the claim. It is unclear whether the bevels refer to at least a first bevel or a second bevel.

#### *Claim Rejections - 35 USC § 102*

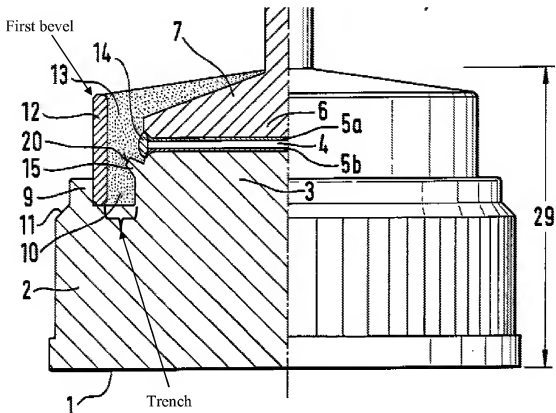
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 15, 16 and 26** are rejected under 35 U.S.C. 102(b) as being anticipated by Spitz et al. (US 6,060,776 A).
7. Regarding **claim 15**, Spitz et al. teach a press-fit diode (rectifier diode 100; Fig. 1, col. 3 lines 15-16), comprising: a head wire (8; Fig. 1, col. 3 lines 21-22); a base (2; Fig. 1, col. 3 line 17); a chip (semiconductor chip 4; Fig. 1, col. 3 lines 19-20) connected via solder layers (solder 5a and 5b; Fig. 1, col. 3 lines 19-21) to the head wire (8) and to the base (2; Fig. 1, col. 3 lines 18-21); at least a first bevel (the bevel at the top outer corner of 12; see Fig. 1 below) located at a top (12 is a top portion of 12, 13, and 2; see Fig. 1 below) of a housing (12, 13 and 2) and a second bevel (press-fit region 11; Fig. 1, col. 3 line 25) located at a bottom (2 is a bottom portion

of 12, 13, and 2) of the housing (12, 13 and 2), wherein the first and second bevels (the bevel at the top outer corner of 12 and 11) enable press-fitting of the diode (100; the bevel at the top outer corner of 12 eases the insertion of the diode and 11 is pressed fitted to the rectifier arrangement 36; see Figs. 2 and 3, col. 4 lines 32-54); and a plastic sheathing (protective sheath 12 and a package 13 of casting resin composition; Fig. 1, col. 3 lines 30-32 and 66-67) which includes a sleeve (protective sheath 12; Fig. 1, col. 3 lines 30-32) and is situated at least in an area around the chip (4; the sleeve 12 surrounds the chip 4; see Fig. 1) and forms a mechanical connection between the base (2) and the head wire (8; see Fig. 1, the sleeve 12 is mechanically connected to 2 and 8), wherein the base (2) at least partially encloses the plastic sheathing (12 and 13) and forms the housing (12, 13 and 2) with the plastic sheathing (12 and 13), and wherein the base (2) includes at least one undercut (shoulder 15; Fig. 1, col. 3 lines 36-37) which extends into the plastic sheathing (12 and 13; see Fig. 1), and wherein a trench (the trench between 12 and 2 filled with 13; see Fig. 1 below) is provided between the sleeve (12) of the plastic sheathing (12 and 13) and the base (2; see Fig. 1 below).



A portion of Fig. 1 of Spitz et al. showing the trench and the first bevel

8. Regarding **claim 16**, Spitz et al. also teach the press-fit diode as recited in claim 15, wherein the base (the base 2) is made of at least one of an electrically conductive material and thermally conductive material (solid metal which is electrically conductive and thermally conductive; col. 1 lines 8-10 and 32).

9. Regarding **claim 26**, Spitz et al. also teach the press-fit diode as recited in claim 15, wherein the housing (12, 13 and 2) is made of at least one of an electrically conductive material and thermally conductive material (the base 2 is made of solid metal which is electrically conductive and thermally conductive; col. 1 lines 8-10 and 32).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. **Claims 17-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Spitz et al. as applied to claims 16 above as can be understood since claim 18 has been rejected under 35 U.S.C. 112.

13. Regarding **claim 17**, Spitz et al. also teach a height of the base (the height of the bulwark 9; Fig. 1, col. 3 line 50) is selected to achieve an adequate clamping of the base (2) and the head wire (8; i.e. the whole construction including 2 and 8, col. 3 lines 40-60).

Spitz et al. do not teach the height of the base is selected to be between 0.5 mm to 0.8 mm.

Parameters such as the height of the base in the art of semiconductor manufacturing process are subject to routine experimentation and optimization to achieve the desired structural

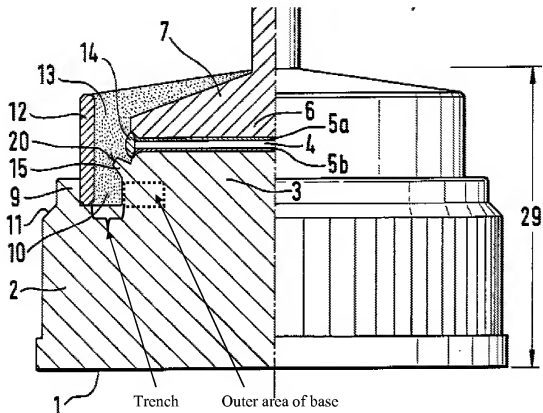
strength during device fabrication. Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the height of the base within the range as claimed in order to achieve the desired structural strength.

14. Regarding **claim 18**, Spitz et al. also teach the press-fit diode as recited in claim 17, wherein the bevels (the bevel at the top outer corner of 12 and 11) enable the diode (100) to be pressed into a rectifier (rectifier arrangement 36; see Figs. 2 and 3, col. 4 lines 32-54).

15. Regarding **claim 19**, Spitz et al. also teach the press-fit diode as recited in claim 17, wherein the plastic sheathing (12 and 13) in the area around the chip (surrounding chip 4) is made up of an area (package 13; Fig. 1, col. 3 lines 30-32) filled with a casting compound (casting resin composition; col. 3 lines 66-67).

16. Regarding **claim 20**, Spitz et al. also teach the press-fit diode as recited in claim 17, wherein the trench (the trench between 12 and 2 filled with 13) has a predetermined depth (see Fig. 1 below) and is provided between the sleeve (12) and an outer area of the base (a portion of base 2 in contact with the right hand side of the trench 10; see the figure below).





A portion of Fig. 1 of Spitz et al. showing the trench and the outer area of base

17. Regarding **claim 21**, Spitz et al. also teach the trench (a portion of the trench 10 not occupied by the sheath 12) has a width (the horizontal width).

Spitz et al. do not teach the trench has a width which is approximately 0.1 mm in at least one area of the trench.

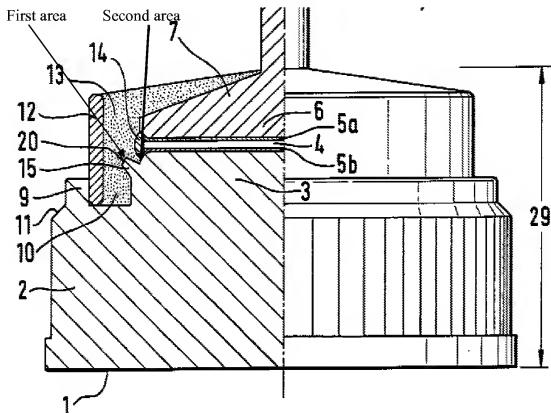
Parameters such as the width of the trench in the art of semiconductor manufacturing process are subject to routine experimentation and optimization to achieve the desired structural strength during device fabrication. Therefore, it would have been obvious to one of the ordinary

skill in the art at the time the invention was made to incorporate the width of the trench within the range as claimed in order to achieve the desired structural strength.

18. Regarding **claim 22**, Spitz et al. also teach the press-fit diode as recited in claim 21, wherein the width (the horizontal width) of the trench (a portion of the trench between 12 and 2 filled with 13 from the bottom of bulwark 9 till the top of the bulwark 9) is essentially uniform over the entire depth of the trench (see Fig. 1).

19. Regarding **claim 23**, Spitz et al. also teach the press-fit diode as recited in claim 21, wherein the width (the horizontal width) of the trench (a portion of the trench between 12 and 2 filled with 13 from the bottom of bulwark 9 till the top of the shoulder 15) is variable over the depth of the trench (see Fig. 1, the horizontal width of the trench varies at the shoulder 15).

20. Regarding **claim 24**, Spitz et al. also teach the press-fit diode as recited in claim 17, wherein the base (2) includes an outer region (shoulder 15; Fig. 1, col. 3 line 37) having a first area (top area) with a first inner diameter (the diameter corresponds to the inner side of the shoulder 15 at the top) and a second area (lower area) with a second inner diameter (the diameter corresponds to the inner side of the shoulder 15 at a lower position) smaller than the first inner diameter (see the figure below).



A portion of Fig. 1 of Spitz et al. showing the first area and the second area

### *Response to Arguments*

21. Applicant's amendments, filed 06/11/2010 and 02/05/2010, overcome the objections to the drawings, the title, and the rejections to claims 15-24 under 35 U.S.C. 112. The objections to the drawings, the title, and the rejections to claims 15-24 under 35 U.S.C. 112 have been withdrawn.

22. On page 6 of Applicant's Response, Applicant argues that all references in IDS 4/10/2006, 11/26/2008, and 4/23/2009 met the requirements of C.F.R. 1.98. The examiner respectfully disagrees. The 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of each

foreign patent and some references in IDS do not have legible copies. Applicant is advised to supply the missing legible copies.

23. Applicant's arguments with respect to claim 15 have been considered but are moot in view of the new ground(s) of rejection. Only the arguments related to the previously presented limitations are addressed in the following. For newly presented limitations, please see the rejections above in this office action.

24. On pages 9 and 10 of Applicant's Response, Applicant argues that by definition, an undercut is a surface that contains a recess within it. However, the shoulder described in Spitz does not contain a recess; instead, the shoulder is specifically described as having an oblique edge. A shoulder with an oblique edge is completely distinct from an undercut and will not perform the same functionalities of an undercut. Therefore, the Spitz reference does not disclose or suggest the presence of the claimed undercut.

25. The Examiner respectfully disagrees with Applicant's argument, because Applicant does not define the term "undercut" in the specification and "undercut" means "a cut or a cutting away underneath" based on the Random House Dictionary, © Random House, Inc. 2010. The shoulder described in Spitz has to have the portion underneath the shoulder to be cut or removed to form a shoulder. Thus the shoulder can be considered as an undercut.

### ***Conclusion***

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hsin-Yi (Steven) Hsieh whose telephone number is 571-270-3043. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne A. Gurley can be reached on 571-272-1670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lynne A. Gurley/  
Supervisory Patent Examiner, Art Unit  
2811

/H. H./  
Examiner, Art Unit 2811  
8/18/2010